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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,229	02/09/2001	Hannu Tahkanen	032221-008	7229

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BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

SCHLAK, DANIEL K

ART UNIT PAPER NUMBER

3653

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,229

Applicant(s)

TAHKANEN, HANNU

Examiner

Daniel K Schlak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- ☐ Interview Summary (PTO-413) Paper No(s). _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines 7-9 is recited the limitation that the pin chips are dosed among chips to be led to subsequent process "immediately upon being separated from the chips" that are to be led to a subsequent process.

The recitation "immediately upon being separated" is portrayed by applicant as being the subject matter over the Admitted Prior Art, namely figures 1 and 2.

However, in light of comparison between the prior art figures and the figures which portray the instant invention, there is no reason to believe that "immediately" is an adequate word for describing "how" or "when" the pin chips are dosed.

In figure 3 there is shown line (6) which depicts the movement of chips from the screening device to the conveyor (7). It is a continuous single line with a single arrow. It represents that chips are being led to the subsequent process "immediately". One arrow, nothing to disrupt it = immediately, by any interpretation of flow charts.

In figure 3 there is also shown lines (9) and (20). These lines represent the movement of the pin chips. Between them there is a device which slows down and/or

stops the movement of the pin chips. The arrow at the end of line (20) represents the point at which "dosing" takes place. Up until this point they are in transit and/or storage.

If the dosing of pin chips onto the conveyor were "immediate", then certainly there would be no need for two lines. In fact, the movement of the pin chips would be shown by a line identical to line (6). The presence of the accumulation area (22) of the doser (19), and the buildup of matter shown therein in figure 5, is a phenomenon which is only interpreted as the opposite of the term "immediate". In fact, the idea of dosing inherently precludes the idea of immediacy. For, if the matter were dosed immediately, it would no be dosing, for all dosing requires some type of preparation and precedent preparation.

Thus, the term "immediately" does little to define over the admitted prior art. What if, in the figure 1, there was very little pin chip matter in the "storage" area? Wouldn't it be dosed "immediately" upon arrival? How does claim 1 define over this possibility? Does this mean that Claim 1 is different from the admitted prior art only when there are many pin chips already being stored?

Returning to figure 5. It is clear that the pin chip matter sitting at the very top of hopper (defined by walls 22 and 25) are not being dosed "right now". Certainly they have arrived at the structure defined as a doser, but they are not being dosed at the exact moment in which Figure 5 was meant to depict. In fact, they have arrived at the doser, but have not yet been dosed. Therefore, the idea that they are dosed immediately is easily repudiated.

Again, the starkest proof of the preclusion of "immediate" is the presence of two lines to represent the conveyance of the stream of matter. If it were "immediate", there would be no second line (20).

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by admitted prior art, figures 1 and 2.

Figure 1 shows a plant for screening wood chips and for subsequently leading chips to a subsequent process comprising at least one separating apparatus (1) to separate pin chips (9) from a quantity (6) of chips to be led to the subsequent process. Figure 1 shows a dosing apparatus (10) *immediately* downstream of the separating apparatus (1). There is a single line, with a single arrow, connecting them. Page 2 of the specification refers to apparatus (10) as a "pin bin... from which a pin chip flow 11 of desired size is dosed back into the subsequent process..." Thus, "pin bin" represents part of the dosing apparatus, if not a complete dosing apparatus by and of itself, especially as line (11), which is the line of the stream of dosed material, leads straight from bin (10) to conveyor (7). Pin chips, according to the description of figures 1 and 2, are *a/ways* being separated by the separating apparatus when the plant is in operation, so that the dosing apparatus is necessarily adapted to dose separated pin chips among

the chips that are to be led to the subsequent process as the pin chips are separated by the separating apparatus.

Response to Arguments

Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Applicant is reminded that the differences between figures 1 (prior art) and 3 (instant invention) are not delineated by any differences in the mass streams, arrows, the separator, or the conveyor. The differences reside in the structural elements of elements (10) and (19). Thus, allowable claims would and should be directed to such differences. As is clear from rejections under 35 U.S.C. 112, 2nd Paragraph, terminology such as "immediately" only muddles the gray area that represents the time interval it takes pin chips leaving the separator to reach the conveyor. The only difference pertinent to such an argument based upon immediacy is in the amount of time a pin chip spends in intermediate storage between falling into storage and actually finding itself in the stream on conveyor 7. For the instant invention such time interval is seconds, whereas in the prior art such time interval is likely in minutes, but in many cases (such as start-up of the plant), can also be measured in seconds. This gray area is certainly not one to be sliced up into sub-intervals defined as "immediate" and "non-immediate", because nothing in such a respect can be defined as purely "immediate", just as the term "not stored" can not by itself preclude the presence of matter in the top layers of a hopper, as was shown in the prior Office action. For instance, someone

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concerned with the biological decomposition of the pin chips, wherein critical spans of time are measured in days and weeks, would certainly find the dosing of pin chips after an intermediate storage of only twenty seconds, immediate, and quite outside his concerns. In other words, immediate is a subjective term, and does not provide an objective period of time of movement or non-movement, storage or non-storage, etc.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

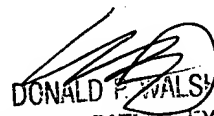
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

dks
March 7, 2003


DONALD F. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600